

REMARKS/ARGUMENTS

Table 3 has been amended to correct a typographical error in column 5 without adding new matter.

Claims 1 and 18 have been amended to add the subject matter of cancelled Claim 3. Claim 4 has been amended to change its dependency.

Claims 7 and 21 have been amended to correct a typographical error in Structure VII.

Claim 16 has been amended to correct a typographical error.

Claim 21 has been amended to delete redundant subject matter.

Claim Objections

Claims 7 and 21 have been amended as suggested by the Examiner. Notice of this error is appreciated.

Rejection Under 35 U.S.C. §112(2)

Claim 16 has been amended to correct the typographic error noticed by the Examiner to overcome this rejection.

Rejections Under 35 U.S.C. §103(a)

I. Claims 1, 2, 5-11 and 13-19 have been rejected as being unpatentable over US 2003/0186165 in view of DD 287,796.

II. Claims 3, 4, and 21 have been rejected as unpatentable over US '165 in view of DD '796 and US 3,686,371 (Hasagawa).

Each of these rejections is respectfully traversed. Rejection I is moot in view of the amendment of Claim 1 to incorporate the subject matter of Claim 3. Thus, the remaining comments are directed to Rejection II.

US '165 and DD '796 are said to teach all of the claimed subject matter except for the use of a copolymerizable compound with a P-OH group. The Office Action then relies on Hasagawa for this missing teaching. This reference alleges that such esters provide superior anti-corrosion, excellent adhesion, fire-retarding, and low temperature curing in coating compositions.

However, there is nothing suggestive in Hasagawa that such copolymerizable units could be useful in lithographic printing plates or radiation-sensitive coatings to improve photosensitivity, yellow light stability, storage stability, and greater run length on a printing press. What does the anti-corrosion property taught by Hasagawa have to do with Applicants' lithographic invention or its improved lithographic photosensitivity, stability and run length? Nothing. What does adhesion taught by Hasagawa have to do with Applicants' invention? Nothing. What does fire-retardation and low temperature curing have to do with improved photosensitivity, stability and run length? Nothing. There is no technical or common sense reason why a skilled working in lithography would consult Hasagawa in order to solve the problems addressed by the presently claimed invention. Nor is there any reason why a skilled worker in lithographic would combine any of its teachings with the other cited art.

The Office Action argues (page 4) that US '165 teaches that additional (meth)acrylate functional monomers can be employed in the disclosed compositions. Yes, but there are hundreds of possible "additional (meth)acrylate functional monomers" in existence that could be chosen. What would motivate a skilled artisan in lithography to pick out those mentioned in Hasagawa? Only hindsight speculation based on the teaching in Applicants' application.

The Office Action also argues that because Hasagawa teaches advantages of adhesion and corrosion resistance that one skilled in the art (which art?) would be motivated by a "reasonable expectation of obtaining compositions having advantageous properties for printing plates". This is mere speculation. Nothing in the teachings of the cited art itself or in Applicants' specification suggests that the use of the technology of Hasagawa would be beneficial for any purpose in printing plates or their unique properties. The cited reference fails to provide any hint of printing plates, and is merely a generic discussion of coating compositions that could have hundreds of speculative uses. The mere fact that those compositions may adhere well or be corrosion resistance is irrelevant to the presently claimed invention or the problems it addresses. This is clearly an example where a feature of Applicants' claimed invention is absent from the lithographic literature so the Examiner has found it in some irrelevant patent literature in an attempt to provide a *prima facie* basis for an unpatentability rejection. Hasagawa could be just as pertinent to automotive paints, floor

coatings, or myriad other adhesive coating but no one skilled in lithography would have a clue that it might be useful in lithography or used in combination with the materials of the other cited art. Thus, the citation of Hasagawa is clearly misplaced, and the unpatentability rejection cannot be supported by the remaining two references. The unpatentability rejection of the pending claims should be withdrawn.

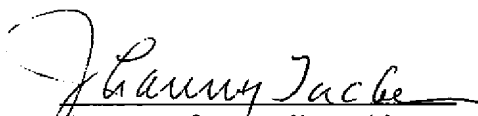
Obviousness Type Double-Patenting Rejection

Claims 1-11, 13-19 and 21 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of co-pending Application No. 10/544,758 [US 2006/0234155], now allowed, in view of US 2003/186,165.

While Applicants traverse this rejection on the merits, in order to expedite prosecution, Applicants are submitting herewith a Terminal Disclaimer disclaiming any portion of a patent issuing on the present invention that would extend beyond the term of any patent issued on pending Application No. 10/544,758. The Terminal Disclaimer is believed to overcome this rejection.

In view of the foregoing amendments and remarks, reconsideration of this patent application is respectfully requested. A prompt and favorable action by the examiner is earnestly solicited.

Respectfully submitted,


Attorney for Applicant(s)
Registration No. 27,678

J. Lanny Tucker/s-p
Rochester, NY 14650
Telephone: (585) 722-9332
Facsimile: (585) 477-4646

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.